

**REQUEST FOR RECONSIDERATION**  
**U.S. Application No.: 09/462,631**

**I. Rejection of claims 1 and 3 under 35 U.S.C. 102(b)**

On pages 2-3 of the Office Action, the Examiner maintains the rejection of claims 1 and 3 under 35 U.S.C. § 102(b) as allegedly being anticipated by Vignaud.

Basically, the Examiner cites Vignaud as teaching making electrodes by compression molding of a dry mixture containing a conducting compound such as graphite, a catalytically active compound (e.g., Ag catalyzed C), PTFE fibers, all mixed with a lubricant such as kerosene or an oil. The Examiner asserts that Ag particles may be present which suffices to read on metal powder as claimed.

Applicants respond as follows.

Vignaud relates to a thin electrode for electrochemical devices or generators (batteries and accumulators, i.e., primary and secondary cells). *See* col. 1, lines 5-7. Therefore, the electrode of Vignaud is not an electrode that can be used for electric discharge surface treatment. Accordingly, Vignaud is not particularly relevant to the present invention.

The Examiner has taken the position that Ag particles may be present since Vignaud discloses, for example, Ag catalyzed C.

Generally, a catalyst is not consumed or does not undergo a chemical change. Therefore, although Vignaud discloses carbon catalyzed by Ag as a catalytic active compound, Ag particles would not be present. Therefore, Vignaud does not disclose a metal powder, as required in the present invention.

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Accordingly, Vignaud does not teach the green-compact electrode of the present invention.

In view of the above, withdrawal of the foregoing rejection is respectfully requested.

**II. Rejection of claims 2 and 4 under 35 U.S.C. 103(a)**

On page 3 of the Office Action, the Examiner maintains the rejection of claims 2 and 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Vignaud.

The Examiner's position is substantially the same as that set forth in the previous Office Action.

In response, Applicants respectfully traverse the foregoing rejection for the reason that claims 2 and 4 should be allowed at least by virtue of their dependence from claims 1 and 3, respectively, which are not taught or suggested by Vignaud as discussed above.

**III. Rejection of claims 5-8 under 35 U.S.C. 103(a)**

On pages 3-4 of the Office Action, the Examiner maintains the rejection of claims 5-8 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Vignaud in view of Magara et al. (U.S. Patent 5,698,114).

Basically, the Examiner's position is substantially the same as that set forth in the previous Office Action.

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In response, Applicants respectfully traverse this rejection for the reason that Vignaud does not teach or suggest the green-compact electrode of the present invention, as discussed above.

In addition, a person of ordinary skill in the art would not be motivated to combine Vignaud and Magara et al.

Vignaud is related to an electrode that can be used in, for example, a battery and Magara et al. is directed to an apparatus and process for forming surface layers on electrodes by electron discharge machining.

The Examiner appears to take the position that one of ordinary skill in the art would combine Vignaud and Magara et al. simply because both references disclose an electrode containing graphite. However, there must be some teaching, suggestion or incentive to support the combination.

In this case, there is no disclosure in Vignaud that would motivate a person of ordinary skill in the art to use Vignaud's electrode as a source for forming a surface layer since Vignaud is directed to an electrode for use, for example, in a battery. Further, there is no disclosure in Magara et al. that would motivate a person of ordinary skill in the art to use Vignaud's electrode in the process of Magara et al. Therefore, a person of ordinary skill would not combine the two references to arrive at the present invention.

Accordingly, withdrawal of the foregoing rejection is respectfully requested.

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**IV. Conclusion**

Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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